

REMARKS

The Office Action dated May 31, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 31, 39, 47, 50, 53, 56, and 59 are amended. No new matter has been added. Support for the amendments to the claims can be found on at least page 26, lines 6-15 of the specification as originally filed. Claims 7-71 are pending and respectfully submitted for consideration.

Claims 7-46 and 62-66 were rejected under 35 U.S.C. § 102(e) as being anticipated by Heo (U.S. Patent No. 6,167,192). 8-14 and 62 depend from claim 7, claims 16-22 and 63 depend from claim 15, claims 24-30 and 64 depend from claim 23, claims 32-38 and 65 depend from claim 31, claims 40-46 and 66 depend from claim 39. The Applicants traverse the rejection and respectfully submit that claims 7-46 and 62-66 recite subject matter that is neither disclosed nor suggested by Heo.

Heo discloses a logic data structure of DVD-video disc, wherein the information regarding audio stream in the control information is disclosed in the audio-stream attribute chart (b63-b0) of Fig. 5. Specifically, the audio stream attribute table of the VTS (VTS_AST_ATRT) of RBP 516 to 579 in the VTSI_MAT having the same structure as that of FIG. 4, stores VTS_AST_ATR #0-#7 RBPs of the eight audio streams, each of the VTS_AST_ATRs having 8 bytes as shown in FIG. 5, and the respective field's values become the internal information of the audio stream of the VTSM_VOBS. See column 5, lines 10-17 of Heo.

With respect to claims 7, 15, 23, 31, and 39 the Applicants respectfully submit that Heo fails to disclose or suggest the claimed features of the invention. Claims 7, 15, 23, 31, and 39 recite, control information including application information indicating whether or not the audio stream recorded in the video data recording area contains audio data intermingled from different recording modes as one stream. The Applicants respectfully submit that there is no disclosure or suggestion, in Heo of at least the feature of the claimed application information. In contrast, Fig. 5 merely indicates application information in b0-b7, but does not indicate whether or not the audio stream recorded in the video data recording area contains audio data intermingled from different recording modes as one stream.

Further, Heo does not disclose or suggest audio data intermingled from different recording modes as one stream. Heo discloses attribute information of audio for each VTS, including a plurality of streams, not one stream. See column 5, lines 10-14 of Heo. Furthermore, b60 in Fig. 5 of Heo is information for indicating whether the multi-channel extension is carried out or not, not information for indicating whether the different recording modes are intermingled or not. As such, Heo fails to disclose or suggest each and every feature of the invention as recited in claims 7, 15, and 23.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim . . .

the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). Accordingly, Heo does not anticipate claims 7-46 and 62-66, nor are claims 7-46 and 62-66, obvious in view of Heo.

Claims 47-61 and 67-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Heo as applied to claims 1-46 and further view of Oguro (U.S. Patent No. 6,097,558). Claims 48, 49 and 67 depend from claim 47, claims 51, 52 and 68 depend from claim 50, claims 54, 55 and 69 depend from claim 53, claims 57, 58 and 70 depend from claim 56, and claims 60, 61 and 71 depend from claim 59. As acknowledged in the Office Action Heo fails to disclose a mixed mode flag. Oguro was cited for curing this deficiency.

Oguro discloses eight-channel audio which are made by six-channel surround audio and two-channel stereo audio as composite audio data. The MIX (1 bit) represents whether or not composite audio data that composites each component is present. When MIX is "0", MIX represents that composite audio data is present. When MIX is "1", MIX represents that the composite audio data is not present. MIX is valid only when CH=011. When CH ≠ 011, MIX should be 1.

The Applicants respectfully submit that the combination of Heo and Oguro fails to disclose or suggest the claimed features of the invention. Claims 47, 50, 53, 56, and 59, as amended, recite a mixed mode flag indicating whether multiplexed audio, multi-channel audio and monaural audio are mixed as one stream. The Office Action took the position that the MIX in Oguro was comparable to the claimed mixed mode flag, (“the mixed mode flag [or MIX bit]”). See at least page 7, line 27 of the Office Action. The

Applicants respectfully submit that the MIX disclosed in Oguro is not comparable to the mixed mode flag recited in claims 47, 50, 53, 56, and 59 at least because Oguro discloses only multi-channels, but does not disclose multiplexed audio.

Specifically, the mixed mode flag of the present invention indicates whether the multiplexed audio, multi-channel audio, and monaural audio are mixed, in which a flag is “1” in the case of the mixed, and “0” in the case of the non-mixed. In contrast, Oguro discloses eight-channel audio which are made by six-channel surround audio and two-channel stereo audio as composite audio data. The “MIX” of Oguro represents whether or not the composite audio data that composites each component is present. When MIX is “0”, it represents that the composite audio data is present, while when MIX is “1”, it represents that the composite audio data is not present. That is, Oguro discloses only multi channels, but does not disclose multiplexed audio. Thus, the “MIX” disclose by Oguro is not comparable to the “mixed mode flag” of the present invention. Accordingly, Oguro does not cure the deficiencies in Heo with respect to amended claims 47, 50, 53, 56, and 59, which recite that the mixed mode flag indicates whether multiplexed audio, multi-channel audio and monaural audio are mixed as one stream.

Under U.S. patent practice, the PTO has the burden under §103 to establish a prima facie case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective

teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

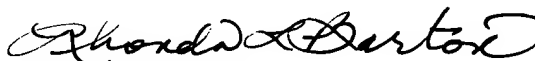
For at least the combination of foregoing reasons the Applicants respectfully submit that the combination of Heo and Oguro does not support a *prima facie* case of obviousness for purposes of a rejection of claims 47-61 and 67-71 under 35 U.S.C. §103.

Claims 8-14 and 62 depend from claim 7, claims 16-22 and 63 depend from claim 15, claims 24-30 and 64 depend from claim 23, claims 32-38 and 65 depend from claim 31, claims 40-46 and 66 depend from claim 39, claims 48, 49 and 67 depend from claim 47, claims 51, 52 and 68 depend from claim 50, claims 54, 55 and 69 depend from claim 53, claims 57, 58 and 70 depend from claim 56, and claims 60, 61 and 71 depend from claim 59. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 7, 15, 23, 31, 39, 47, 50, 53, 56, and 59. Accordingly, the Applicants respectfully request allowance of claims 7-71 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107156-09071.**

Respectfully submitted,



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Enclosure: Petition for Extension of Time (three months)